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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|---------------------|
| 10/779,980 | 02/17/2004 | Michael H. Heggeness | 89072 CIP | 8886 |
| 23505 | 7590 | 06/15/2006 | EXAMINER | |
| CONLEY ROSE, P.C. P. O. BOX 3267 HOUSTON, TX 77253-3267 | | | | PELLEGRINO, BRIAN E |
| | | ART UNIT | | PAPER NUMBER |
| | | | | 3738 |

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|-----------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/779,980 | HEGGENESS, MICHAEL H. | |
| | Examiner | Art Unit | |
| | Brian E. Pellegrino | 3738 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 27 March 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 28-39 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 28-39 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 28-35, 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Coates et al. (US 5423826). Coates discloses a plate (20) with a preformed shape having a radius of curvature (column 2, lines 55-57, Figure 3) and slots (159) at each end for insertion of arm end hook (161) (column 13, lines 9,10). The plate also contains fixation bores (27) at each end, which are interpreted as loops. All materials contain an elastic range of movement and a failure point where the deformations become permanent and therefore all plates will contain an elastic shape and a deformed shape if an adequate deformation mechanism is employed. Referring to figure 17 of Coates, the plate is fully capable of being deformed to an intermediate elastic shape and a final deformed shape by tightening the threaded locking rod (155) as necessary to achieve multiple radii of curvature which are capable of corresponding to various bone radii of curvatures. Coates also discloses a plate holder/guide that is capable of being a tensioner as described above. The plate holder includes a shaft as one of the at least two arms (151,152) or bridge portion (153) and base portions (157) that contain hooks (161, column 13, lines 9-10) which are also spatula members that releasably engage the plate between the arms. The shaft/arms have at lease one screw groove for the threaded locking rod (155) and are attached with a pivot bolt (160) as a hinge member

(column 13, lines 58-63) disposed along the longitudinal axis, the shafts second end being connected to the base (157) by pivot point dowels (165) which allows the bases (157) rotate about the pivot dowel while the shaft is stationary where the pivot dowel is a base shaft and resides in a cavity of the shaft. The force exerted on the plate positioned between the arms and tightened by tensioner 155 is capable of altering the curvature of the plate, col. 13, lines 9-11,62-68.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 28,35,36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Judet (4263904) in view of Rouse (2002021). Judet discloses (Fig. 1) a bone plate 1 having a radius of curvature. Judet also discloses (Fig. 12) a tensioner tool having a base and two arms adapted to be releasably secured to the plate. However, Judet does not disclose a shaft with a screw groove to facilitate movement of the arms or that the shaft is rotatably coupled to the base by a ball joint. Rouse teaches (Fig. 1) a bone system device having a shaft with a threads 5 and is connected to a base 8. Rouse also teaches (Fig. 4) that ball joints can be rotatably connected with the system. Rouse also teaches that the spreader is able to be controlled because of the shaft and threads, col. 2, lines 30-34. It would have been obvious to one of ordinary skill in the art to substitute the tensioner tool of Judet with the tensioner tool of Rouse such that it provides greater degrees of freedom when implanting the plate in the patient.

Additionally, the spreader of Rouse gives the surgeon more control in setting the plate in position and having a "locked" position as a result of the threads preventing movement, whereas the Judet tool does not necessarily lock.

Response to Arguments

Applicant's arguments filed 3/27/06 have been fully considered but they are not persuasive. Applicant argues that the Coates device does not releasably engage the plate between the arms of the tool. However, it is the Examiner's position that as seen in Fig. 17 the base portion 157 is on both arms and has a slot to receive the plate between the arms of the tool. In response to applicant's argument that Coates' tensioner is not capable of facilitating movement of the plate to change its curvature, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Applicant has failed to show any difference in structural features between the Coates apparatus and the present claims. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958

F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Rouse provides the ability of a surgeon to have more control of the plate and can place more tension or less on the plate as a result of the base and threaded shaft of the Rouse's tensioner.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Thursday from 6:30am to 4pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

BRIAN E. PELLEGRINO
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Brian E. Pellegrino". The signature is written in a cursive, fluid style with a clear 'B' at the beginning and a 'P' at the end.